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10/826,681	04/16/2004	Cesur Celik	7012-X04-002	9588

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EXAMINER

MAI, NGOCLAN THI

ART UNIT PAPER NUMBER

1742

DATE MAILED: 03/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/826,681

Applicant(s)

CELIK ET AL.

Examiner

Ngoclan T. Mai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 8-11, 16 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 12-15 and 18-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. This application contains claims directed to the following patentably distinct species of the claimed invention: a) nickel-base metal alloy and b) Cu-base metal alloy.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-4, 13-15 and 20 are generic.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with applicant's attorney Martin Fleit on March 2, 2005 a provisional election was made without traverse to prosecute the invention of species a) claims 5-7, 12 and 18-19. Affirmation of this election must be made by

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applicant in replying to this Office action. Claims 8-11 and 16-17 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 18-19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 11124606 A.

The reference discloses nickel copper alloy powder containing 5-60% of copper (40-95% Ni) and having mean particle diameter of 0.1 to 5 microns. The nickel copper alloy powder taught is used as internal electrode material of laminated ceramic capacitors.

Regarding the claimed temperature at which onset of oxidation is occurred in claims 18-19, it appears the claimed property is material property. Consequently, the

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properties as recited in the instant claims would have inherently possessed by the teachings of the cited references. Therefore, the burden is on the applicant to prove that the product of the prior art does not necessarily or inherently possesses characteristics attributed to the claimed product. In re Spade, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990), In re Best, 195 USPQ 430 and MPEP § 2112.01.

6. Claims 1-5, 12, 15, 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Holtz, Jr. (US 3,502,463).

Holtz discloses the claimed nickel base alloy powders having compositions (in weight percent) a) 12.5 W, 10 Co, 10 Cr, 3Ti and 1.5 Al; b) 15 W, 10 Co, 15 Cr, 3 Ti and 1.5 Al; and c) 14.4 W, 9.6 Co, 16.6 Cr, 3 Ti, 1.4 Al. See Table I. The nickel base alloy powders taught are produced by gas atomization and have spheroidal shape, see col. 3, line 29 to col. 4, line 6. Since the nickel-base alloy powders taught is the same as the claimed base metal alloy powder with Ni as the base, the property as recited in claims 18-19 would have inherently possessed by the teachings of the cited reference. Therefore, the burden is on the applicant to prove that the product of the prior art does not necessarily or inherently possesses characteristics attributed to the claimed product. In re Spade, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990), In re Best, 195 USPQ 430 and MPEP § 2112.01.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11124606 A.

The reference discloses the alloy powder substantially as claimed. The differences between the claims and the reference is that the reference does not specifically teach the alloy comprises at a least 60% by weight of Ni and the average particle size of the alloy powder.

However it would have been obvious to one of ordinary skill in the art to select any portion of range, including the claimed range, from the broader range disclosed in the reference (40-95% Ni and 0.1 to 5 microns in size) because reference finds that nickel copper alloy powder containing nickel and having particle size in the entire disclosed range has a utility as internal electrode material. --- Note: Even if a reference teaches a preferred range within a broader range, it still does not "teach away" from the claimed invention. See MPEP 2123.

9. Claims 2-3, 5, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11124606 A in view of JP411067588A.

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JP 11124606 A discloses Ni-Cu alloy powder substantially as claimed. The difference between JP 11124606 A and the claims is that JP 11124606 A does not specifically teach the presence of Cr in the alloy.

JP411067588 teaches a conductive material for internal electrode formed of either one of Cu, Ni or their alloy as the main component and as a subcomponent, at least one or more kinds from among P, Cr, Fe, Al, Si, Co, W, Mn, Sn, Mo and B, see abstract. JP411067588 discloses employing 8% of Cr as the subcomponent in table 1.

Since Cr is taught to be suitable for combining with Ni-Cu alloy for making internal electrode for laminated ceramic capacitor, the employment of such material in the Ni-Cu alloy powder taught by JP 11124606 for making the same is well within the level of ordinary skill in the art and would have been obvious.

10. Claims 1, 12-14, 18-19 and 20 rejected under 35 U.S.C. 103(a) as being unpatentable over JP11092807.

The reference discloses a powder of nickel tungsten alloy containing 5-40% of tungsten (60-95% Ni) having mean particle diameter of 0.1 to 1 micron, which is used as internal electrode material of lamination ceramic capacitors.

The difference between the claims and the reference is that the reference teaches tungsten in the amount that is overlapping that of the applicant. However it would have been obvious to one of ordinary skill in the art to select any portion of range, including the claimed range, from the broader range disclosed the reference because reference finds that nickel tungsten alloy having tungsten in the entire disclosed range

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has a utility as internal electrode material. --- Note: Even if a reference teaches a preferred range within a broader range, it still does not “teach away” from the claimed invention. See MPEP 2123.

*When prior art compounds essentially “bracketing” the claimed compounds in structural similarity are all known, one of ordinary skill in the art would clearly be motivated to make those claimed compounds in searching for new products in the expectation that compounds similar in structure will have similar properties. In re Gyurik, 596 F.2d 1012, 1018, 201 USPQ 552, 557 (CCPA 1979); See In re May, 574 F.2d 1082, 1094, 197 USPQ 601, 611 (CCPA 1978) and In re Hoch, 57 CCPA 1292, 1296, 428 F.2d 1341, 1344, 166 USPQ 406, 409 (1970). Therefore, the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the subject matter disclosed by the references. Overlapping ranges have been held to be a prima facie case of obviousness. See In re Malagari, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974).*

Regarding the claimed temperature at which onset of oxidation is occurred in claims 18-19, it appears the claimed property is material property. Consequently, the properties as recited in the instant claims would have inherently possessed by the teachings of the cited references. Therefore, the burden is on the applicant to prove that the product of the prior art does not necessarily or inherently possess characteristics attributed to the claimed product. In re Spade, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990), In re Best, 195 USPQ 430 and MPEP § 2112.01.




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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoclan T. Mai whose telephone number is (571) 272-1246. The examiner can normally be reached on 9:30-6:00 PM Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Ngoclan T. Mai  
Primary Examiner  
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n.m.